

Serial No.: 09/989,181
Response to OA of 04/06/2006

Remarks

In the present response, no claims are amended. Claims 1-43 are presented for examination.

I. Claim Rejections: 35 USC § 103(a)

Claims 1, 25-38, 42, and 43 are rejected under 35 USC § 103(a) as being unpatentable over USPN 6,834,250 (Uchiyama) in view of USPN 6,883,019 (Sengupta). This rejection is traversed.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. For at least the following reasons, Applicant asserts that the rejection does not satisfy these criteria.

No Suggestion/Motivation to Modify/Combine References

For at least the following reasons, no suggestion or motivation exists to modify or combine Uchiyama in view of Sengupta.

First, Applicant argues that no teaching or suggestion exists to make the combination because the references are directed to completely different inventions. Uchiyama is directed to correcting errors for images appearing on a display of a camera. Specifically, the method corrects errors that exist between the actual position of a landmark captured by the camera and the position of the landmark predicted based on sensed position and orientation of the camera (3: 16-24). **By contrast, Sengupta teaches a completely different invention.** Sengupta teaches a user connects to the internet with a computer to register with a server and select communications to receive on a communication device (1: 35-45). Before sending information to the user's communication device, the server considers context of the information so "the user receives individualized information relevant to his/her habits, lifestyle, and real-time status" (1: 55-58).

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The Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Such teaching or suggestion does not exist.

Second, Applicant argues that no teaching or suggestion exists to make the combination because the references are directed to solving completely different problems. In Uchiyama, the Background section discusses the problems with prior cameras attempting to improve the position and orientation of the camera for capturing images (see 1: 35-46). Uchiyama specifically states that the invention is “developed to solve the above mentioned problem, and aims at correcting the parameter indicating the position and orientation of a camera by reflecting a captured landmark” (2: 9-12). **By contrast, Sengupta solves completely different problems.** In Sengupta, the Background section discusses that a user of a communication device (such as a cellular phone) can register to receive scheduled information from the internet (1: 8-14). The problem is that the information sent to the communication device is “static” (1: 19-20).

To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

In light of the completely different inventions and problems being solved in Uchiyama and Sengupta, no suggestion or motivation exists to combine or modify these references.

For at least these reasons, Applicant respectfully asks the Examiner to withdraw the rejection since a *prima facie* case of obvious has not been established.

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that a user of a communication device "receives individualized information relevant to his/her habits, lifestyle, and real-time status" (1: 55-58). By complete contrast, Uchiyama corrects errors that exist between the actual position of a landmark captured by the camera and the position of the landmark predicted based on sensed position and orientation of the camera (3: 16-24).

In view of these deficiencies, the Office Action has failed to establish a reasonable expectation of success with a combination or modification of Uchiyama and Sengupta. Therefore, the *prima facie* case of obviousness has not been established.

All Elements Not Taught or Suggested

All of the elements of the claims are not taught or suggested in Uchiyama and Sengupta. In other words, evening assuming *arguendo* that Uchiyama and Sengupta are successfully combinable (which they are not), the alleged combination does not teach or suggest all the elements in the claims.

By way of example, independent claim 1 recites an image capturing device that captures and displays an image containing a landmark. The claim then recites that a context interpretation engine "generates contextual information relating to the landmark" (emphasis added). The Office Action **admits** that Uchiyama does not teach this recitation (see OA at end of p. 2 to p. 3). Applicant agrees with this admission. The Office Action, however, attempts to cure this deficiency with Sengupta at column 1, lines 51-58. Applicant respectfully disagrees.

Sengupta teaches a user connects to the internet with a computer to register with a server and select communications to receive on a communication device (1: 35-45). Before sending information to the user's communication device, the server considers context of the information so "the user receives individualized information relevant to his/her habits, lifestyle, and real-time status" (1: 55-58). Notice that column 1, lines 51-58 has nothing to do with generating contextual information "relating to a landmark" captured by an image capturing device. Again, this section teaches contextual information for an entirely different purpose: to provide a use with individualize information relevant to his/her habits, lifestyle, and real-time status.

in section I with respect to the independent claims, the respective dependent claims are also allowable.

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